



02 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of YORK et al.
Application No.: 10/070,093
PCT No.: PCT/GB00/03328
Int. Filing: 31 August 2000
Priority Date: 31 August 1999
Attorney Docket No.: 0113.00
For: COFORMULATION METHODS
AND THEIR PRODUCTS

: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.47(a)
:
:
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This is a decision on applicant's "Renewed Petition under 37 CFR 1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 24 February 2003.

BACKGROUND

On 01 May 2002, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration executed by the inventors and a surcharge for filing the oath or declaration after the thirty month period was required.

On 31 July 2002, in response to the Notification of Missing Requirements, applicants filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) along with a request for a one month extension of time. The petition requested the acceptance of the application without the signature of inventor, Dr. Ronald Harland, on the grounds that the nonsigning inventor was unavailable to execute the declaration. The petition included the requisite petition fee and a declaration signed by the 37 CFR 1.47(a) applicant/inventors, Peter York, Simon A. Wilkins, Richard Anthony Storey and Stephen Ernest Walker, on behalf of Ronald Scott Harland.

On 19 December 2002, a decision was mailed to applicants dismissing the petition under 37 CFR 1.47(a) on the grounds that petitioner had not provided sufficient evidence to support a finding that the nonsigning inventor refused to sign the declaration. Specifically, Petitioner did not provide the last known address of the non-signing inventor Ronald Scott Harland and had not submitted any showing that the non-signing inventor was provided with a copy of the application papers, that is, the specification, including claims, drawings, along with an oath or declaration for his signature.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-

signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1) and (4) were previously satisfied.

With regard to item (3), a statement of the last known address of the non-signing inventor has now been submitted. With respect to item (2), counsel for applicant states that he resubmitted copies of the application papers (specification, drawings, declaration and preliminary amendment including pending claims) to Dr. Harland on 11 February 2003 via facsimile and via Federal Express. Counsel confirmed the last known address for Dr. Harland and has supplied it with his petition. Counsel further states that he "spoke with Dr. Harland on Friday, February 14, 2003 at approximately 10:00 a.m. PST", that Dr. Harland confirmed receipt of the application papers and that Dr. Harland stated that he would not sign the declaration.

Counsel, having firsthand knowledge of the facts, has provided a statement of facts along with the time and place of the refusal and proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor expressly refused to sign the application papers.

Petitioner has now satisfied Items (2) and (3). For these reasons, petitioner has presented sufficient evidence to conclude that applicant/inventor refused to sign the application. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

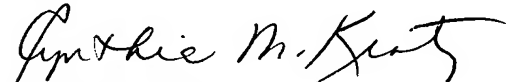
CONCLUSION

The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 31 July 2002 and to mail a filing receipt. The application has an international filing date of 31 August 2000 under 35 U.S.C. 363, and a date of 31 July 2002 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.



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UNITED STATES PATENT AND TRADEMARK OFFICE

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AND THEIR PRODUCTS	:

Dear Dr. Harland:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
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OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Ronald Scott Harland) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/GB00/03328 and was filed on 31 August 2000 in the names of Peter York, Simon A. Wilkins, Richard Anthony Storey, Stephen Ernest Walker, and Ronald Scott Harland for the invention entitled Coformulation Methods and Their Products. The national stage application is assigned number 10/070,093 and has a 35 U.S.C. 371(c) date of 31 July 2002.

Draft Petition Decision

Serial No. 10/070,093

Date of Draft 01 Jul

Legal Examiner Keat

Conferee Approval _____

Petitions Book Nos. _____

Petition Log Book No. _____

PALM Petition Code _____

Charge Account No. _____

Fee _____

Code _____

Fee _____

Code _____

Fee _____

Code _____

Fee _____

Code _____

Granted ☒ _____

Dismissed ☐ _____

Dismissed with Recommendation ☐ _____